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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 14

Application Number: 09/702,737
Filing Date: November 01, 2000
Appellant(s): LUDWIG ET AL.

Frank L. Bernstein
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed March 4, 2003.

(1) Real Party in Interest

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A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 21-41 stand or fall together.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

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(9) Prior Art of Record

5,195,086 Baumgartner et al. 3-1993

Marshak, "BeyondMail for Windows: epitomizing the mail-enabled application" Patricia Seybold's Office Computing Group, v.15 n.9 (Sept. 1992) (Computer Select full-text copy).

Rangan et al., "Software Architecture for Integration of Video Services in the Etherphone System" IEEE Journal of Selected Areas in Communications, v.9 n.9 (1991), pp.1395-1404.

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 21-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baumgartner et al. US patent 5,195,086 and further in view of Marshak "BeyondMail for Windows" and Rangan et al. "Software Architecture for Integration of Video Services in the Etherphone System".

As per claim 21, Baumgartner teaches a teleconferencing essentially as claimed, comprising:

a plurality of video display [inherent in fig.1 workstation A, B, & C]; having audio capture and reproduction capabilities [col.15 lines 5-15];

at least a communication path [fig.1];

wherein the system is configured to display a directory [fig.18]; and

to initiate collaboration upon selecting one or more participants from the display and establish communication with each selected participant [col.18 lines 51 col. 19 lines 13].

Baumgartner does not specifically disclose first and second directory in which the second directory is a subset of the first directory. Marshak discloses that it is known in the collaborative art to provide global and private directories (address books - see page 4 "Managing address book"). It would have been obvious for one of ordinary skill in the art to provide a private second directory which is a subset of the global directory because it would have enable the user to more efficiently group and identify the participants.

Baumgartner does not specifically disclose usage of video or video captured capabilities, and the directory including video-enabled participants. Rangan teaches a system for video/audio conferencing having video capture capabilities for multimedia conferencing. It would have been obvious for one of ordinary skill in the art to have video capabilities with Baumgartner system because it would have enhanced the collaborative interactions among the users. Marshak discloses that the directory can include any type of information to

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provide complete "rolodex-like" functionality. It would have been obvious, in the system as modified, to provide in the directory capabilities of the participants (e.g. video-enabled, audio-enabled, data-enabled, etc.) because it would have enabled a user to be informed about the capabilities of other potential participants.

As per claim 22, Baumgartner teaches using icon and text [see fig.19].

AS per claim 23, Rangan teaches selecting communication types [p.1397 col.2]. Baumgartner teaches using GUI for selecting participant and collaboration applications. Hence, it is apparent the system as modified would have GUI means for selecting the communication type. It would have been obvious for one of ordinary skill in the art to enable the participant to select the conferencing type because it would enable efficient and flexible use of the conferencing system.

As per claim 24, the communication types provided would have been a matter of design choice because it is dependent upon the capabilities of the conferencing system at hand. The method of providing iconic participants directory method would operate essentially the same way regardless of what communication types is available. One of ordinary skill in the art would have known to provide means for the participant to select any communication

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type available in the system so as to enable the participants to make full use of the conferencing services.

As per claim 25, Baumgartner teaches graphic user interface for selecting the participants.

As per claim 26, Baumgartner teaches a default collaboration type upon selecting of a participant [col.19 lines 21-22 'phone'].

As per claim 27, Baumgartner teaches adding new participant [col.22 lines 56+]

As per claim 28, Rangan teaches reproducing audio/video for another participant [p. 1402 col.2 "video document"].

As per claim 29, the references do not specifically disclose hot key for selecting a participant. It is well known in the art to provide hot key for quick access too menu and other application functions. Hence, it would have been obvious for one of ordinary skill in the art to provide a hot key to select a participant because it would have enable to use to have quick, convenient access to the directory

Claims 30-41 are rejected under similar rationales as for claims 21-29 above.

(11) Response to Argument

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Applicant argued that the teaching of Marshak can not be applied to a video conference system because Marshak does not teach means to establish a video conference from the directory information. The argument is not persuasive because Baumgartner teaches a conferencing system having a graphical directory where a user can establish a conference by selecting the participants from a directory [see fig.18 & col.18 lines 65]. Hence, Baumgartner had the mechanic for establishing a conference from selection of participants in a directory. Baumgartner does not specifically disclose a two level directory. Marshak discloses that it is well known to have such a two level directory (global and private). Although not specifically disclosed in Marshak's article, it is well known that a user would store in the private directory addresses for quick access (including personal addresses and corporate addresses from the global directory). The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Given the teaching of Marshak, it would have been

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obvious for one of ordinary skill in the art to provide the system of Baumgartner with private directory to enable each user to store personal contact list for quick access.

Applicant argued that Marshak's private directory is not a subset of the global directory. The argument is not persuasive because the private directory only needs one entry in common with the global directory to be a 'subset' as claimed. It is apparent that the private directory can contain addresses from the global directory for quick look up. Hence, the private directory inherently is a subset of the global directory as claimed.

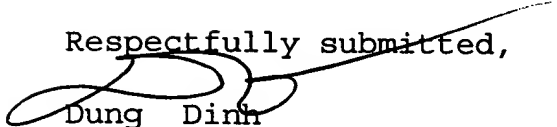
For the above reasons, it is believed that the rejections should be sustained.

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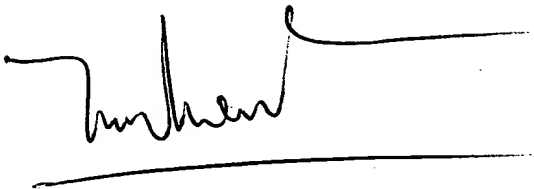
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Respectfully submitted,


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May 12, 2003

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